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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,924	09/11/2000	Glen T. Cunkle	A-22082/P2/CGC 2041	4000
324	7590	12/02/2003	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION			ALVO, MARC S	
PATENT DEPARTMENT			ART UNIT	PAPER NUMBER
540 WHITE PLAINS RD			1731	
P O BOX 2005				
TARRYTOWN, NY 10591-9005			DATE MAILED: 12/02/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/658,924	CUNKLE ET AL.	
	Examiner	Art Unit	
	Steve Alvo	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11-03</u> | 6) <input type="checkbox"/> Other: _____                                    |

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The election of species requirement was made Final in Paper No. 6.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as obvious over WO 99/05108.

WO 99/05108 teaches, page 55, example (g), a compound of the formula: (N,N,N',N'-Tetramethyl-N,N-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-2-hydroxypropyl]-hexamethylenediammonium dibromide. See Example 1 and Abstract, for using 0.5 to 0.1% of the elected species for preventing loss of brightness and for enhancing resistance to yellowing of a lignin containing pulp, e.g. chemimechanical and thermomechanical. See Abstract for adding UV absorbers and polymeric inhibitors and metal chelating agents as co-additives. The claimed N,N,N',N'-Tetramethyl-N,N-bis-[2-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium Dibromide would have been an obvious variant of N,N,N',N'-Tetramethyl-N,N-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-2-hydroxypropyl]-hexamethylenediammonium Dibromide of Example (g) on page 55 of WO 99/05108 as WO 99/05108 teaches the alternativeness of using alkyl chains containing 1 to 4 carbon atoms interrupted with two oxygen's and further not interrupted or interrupted with two hydroxyl groups, See WO 99/05108, page 39, for alternative R1's. Also see, page 8, lines 6-20. Applicant should compare the claimed N,N,N',N'-Tetramethyl-N,N-bis-[2-(1-oxyl-2,2,6,6-

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tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium Dibromide to the (N,N,N',N'-Tetramethyl-N,N-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-2-hydroxypropyl]-hexamethylenediammonium dibromide of WO 99/05108.

Applicant argues that the difference between the compound of Example 18 of the instant Application, and the compound on page 55 of WO 99/05108 is that the compound of WO 99/05108 alkylene groups with secondary hydroxyl groups are not analogous to the present straight chain alkylene groups (e. g. ethylene). However, the alternativeness of using alkylene chains containing 1 to 4 carbon atoms interrupted with two oxygen's and not interrupted or interrupted with hydroxyl groups is taught by WO 99/05108, on page 39 and page 8, lines 6-20. Thus, it would have been obvious to the artisan to substitute an alkylene chain interrupted with only two oxygen's for one interrupted by both two oxygen's and two hydroxy groups.

**When filing an "Official" FAX in Group 1730, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file. The "Official" FAX phone number for this TC 1700 is: 703-872-9306.**

Any inquiry concerning this communication or earlier communications from the **primary examiner** should be directed to **Steve Alvo** whose telephone number is (703) 308-2048. The Examiner can normally be reached on Monday - Friday from **6:00 AM - 2:30 PM (EST)**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Steve Griffin, can be reached on 703-308-1164.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is **703-308-0661**.

msA  
11-26-03

  
STEVE ALVO  
PRIMARY EXAMINER